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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,903	10/12/2001	Thomas J. Murray	79069ADAN	2305

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EXAMINER

BRINICH, STEPHEN M

ART UNIT PAPER NUMBER

2625

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/975,903	Applicant(s) MURRAY ET AL.	
	Examiner Stephen M. Brinich	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-26 and 30-34 is/are rejected.
- 7) ☒ Claim(s) 7,11 and 27-29 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-10, 12-26, & 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sano in view of Adachi et al (EP 0890870).

Re claims 1-2, 13, 16-17, 23, 25, 30-32, & 34, Sano discloses (column 2, lines 2-40) an image printing system in which a plurality of optical images are subject to pre-print digital enhancement, with an amount of enhancement determined for each individual image so as to produce the highest quality rating for the image enhancement algorithm used.

Sano does not describe the printing of a given image both with and without enhancement.

Adachi et al (Abstract; page 3, line 35 - page 4, line 1) discloses a system for printing a plurality of versions of a given image, including one standard image and at least one

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processed image, in order to allow an end user to view the different final appearances. Adachi et al further discloses (page 4, lines 21-26) selecting particular images from the plurality of versions.

Sano and Adachi et al are combinable because they are from the field of image enhancement and enhanced image production.

The printing and display of processed and non-processed images in Sano would be an expedient obvious to one of ordinary skill in the art. The motivation for doing so would be to allow a user evaluation of the Sano enhancement, similar to the user evaluation described by Adachi et al.

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claims 1-2, 13, 16, 23, 25, 30-32, & 34.

Re claims 4-6, 12, & 30-33, Adachi et al describes (Abstract) image tone (e.g. flesh tone, red-eye tone) and image sharpness (which is inherently related to image focus, as an out-of-focus image will be unsharp) as types of image enhancement performed.

Re claims 8 & 33, Adachi et al does not disclose the generation of a message for the consumer. The use of text to label images would be an expedient of obvious skill in the art. The motivation for such labeling would be distinguish two

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similar images (such as, in the case of the present art, the same image with and without a given processing) would be an expedient obvious to one of ordinary skill in the art.

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claims 8 & 33.

Re claim 9, Adachi et al further discloses (page 17, lines 42-44) that the images are obtained optically, and that one has been subjected to improvement.

Re claim 14 & 17, Adachi et al further discloses (Figure 5; page 17, lines 33-44) side-by-side printing of the two images in a line.

Re claims 3, 10, 15, 18-19, & 22, Adachi et al further discloses (Figure 1; page 4, lines 27-28) the use of two separate photo printers (printer 60 and a "DIFFERENT DIGITAL PHOTO PRINTER SYSTEM" connected via communication port 76), which would inherently produce output on two different sheets, readable on the recited "index print" and "standard print" or "first index print" and "second index print".

Re claims 20-21 & 26, Sano in view of Adachi et al does not describe the transmission of the images to a remote display location via a data connection such as the Internet. The use of the Internet to transfer data to a remote location for display

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is well known to one of ordinary skill in the art. The transmission of the enhanced and unenhanced images described by Sano in view of Adachi et al via such a connection would be an expedient of ordinary skill in the art. The motivation for such an arrangement would be to permit a customer to review these images from a convenient location (such as a shopping-mall kiosk or the customer's home).

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claims 20-21 & 26.

Re claim 24, Sano in view of Adachi et al describes the generation of a final output in the form of an image print rather than an image placed on a CD. The use of a CD as a medium to store data, such as an image, is well known to one of ordinary skill in the art. The output of the final image output of Sano in view of Adachi et al to a CD would be an expedient of ordinary skill in the art. The motivation for such an arrangement would be generate an output in a more convenient format (e.g. the storage of a large number of images on a single CD rather than a large sheaf of printouts).

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claim 24.

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Allowable Subject Matter

3. Claims 7, 11, & 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Re claim 7, the art of record does not teach or suggest the recited weighting arrangement of image enhancement factors in conjunction with the recited arrangement for generating and printing sets of enhanced and unenhanced images.

Re claim 11, the art of record does not teach or suggest the recited face image selection arrangement in conjunction with the recited arrangement for generating and printing sets of enhanced and unenhanced images.

Re claim 27 (and dependent claims 28-29), the art of record does not teach or suggest the recited assignment of a value representative of an amount of applied image enhancement in conjunction with the recited arrangement for generating and printing sets of enhanced and unenhanced images.

Response to Arguments

4. Applicant's arguments in the Response filed 1/23/06 (page 9, lines 1-4) with respect to the rejection of claim 12 under 35 USC §112 have been fully considered and are persuasive. The rejection of claim 12 under 35 USC §112 has been withdrawn.

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5. Applicant's arguments filed 1/23/06 have been fully considered but they are not persuasive.

Applicant argues (1/23/06 Response: page 9, lines 8-19) that Sano does not disclose or suggest printing or displaying of a digitally enhanced image with the original, unenhanced image.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues (1/23/06 Response: page 9, line 20 - page 10, line 2) that Adachi et al does not disclose or suggest the selection of an image from a plurality of images

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Re claims 3 & 18, Applicant argues (1/23/06 Response: page 10, lines 3-6) that neither Sano nor Adachi et al, separately or

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in combination, discloses printing a digitally enhanced image on an index print and an unenhanced image on a standard print.

As noted above, Adachi et al discloses (Abstract; page 3, line 35 - page 4, line 1; Figure 1) the printing of enhanced and unenhanced images.

Re claim 24, Applicant argues (1/23/06 Response: page 10, lines 7-11) that it would not be obvious to store the Adachi et al enhanced and unenhanced images on a CD, arguing that this would defeat the purpose of side-by-side image comparison as described by Adachi et al.

However, it is not clear how the storage of images on a CD would interfere with such a comparison. Further, such storage would facilitate comparison at a later time in order to (for example) compare expected and actual results in Adachi et al.

Applicant argues (1/23/06 Response: page 10, lines 12-16) that Adachi et al does not teach the recited red-eye, under-exposure compensation, noise reduction, or flesh tone operations.

As noted above, Adachi et al describes (Abstract) image tone (e.g. flesh tone, red-eye tone) processing.

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Conclusion

6. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

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Hand-carried correspondence may be delivered to the
Customer Service Window, located at the Randolph Building, 401
Dulany Street, Alexandria, VA 22314.

A handwritten signature in black ink that reads "Stephen Brinich". The signature is written in a cursive style with a large, stylized 'S' and 'B'.

Stephen M Brinich

Examiner

Technology Division 2625

smb

April 12, 2006